

d. Remarks

Rejections under 35 U.S.C. §§ 102, 103

At pages 3 – 4, the Office Action states that Cheong and Hur's Declaration of
5 Aug. 28, 2003 (Herein, Declaration I.) and supporting Exhibits 1 – 4 are insufficient to overcome Brinkman. In particular, at page 4, the Office Action states:

In the period in question, the inventors have only asserted that they had met at least once with Mr. McCabe. No evidence has been provided and diligence has not been shown for the critical period. Additionally, the declaration does not
10 contain an allegation that the acts of conception and diligence were carried out in this country or in a NAFTA or WTO member country.

Applicants submit that evidence has been provided for diligence during a critical period that started prior to the Mar. 8, 2001 publication of Brinkman and ended at the Mar. 12, 2001 filing of U.S. provisional patent application 60/275,067. Herein, additional
15 evidence of diligence is also provided. The additional evidence includes:

- a) Supplemental Declaration under 37 C.F.R. 1.131 by S.-W. Cheong and N. Hur (Herein, Declaration II.).
- b) Exhibit A -- a copy of a portion of Dr. Cheong's calendar for Mar. 9, 2001.
- c) Declaration under 37 C.F.R. 1.132 by J. McCabe (Herein, Declaration III).

With respect to conception in the United States

At par. 5, Declaration II states:

... page 23 of Dr. Cheong's notebook for recording new discoveries ... was
25 located in New Jersey, USA, prior to March 2001.

Also, page 23 of Dr. Cheong's notebook corroborates a complete conception of claim 8 as described in Declaration I, pars. 4 – 6, and in the Response of Sept. 2003. Thus, the notebook page shows U.S. conception by the inventors prior to Mar. 1, 2001.

30 With respect to diligence activities in the United States

At par. 6, Declaration II states

With respect to paragraphs 13 – 15 of Our Earlier Declaration, which describes Mr. Hur's experiments ... and Notebook pages shown in earlier Exhibits 2 – 4, Mr. Hur performed those experiments in Murray Hill, New Jersey, USA.

Thus, Mr. Hur's experiments were performed in the U.S. Furthermore, Declaration I, pars. 13 – 15, and previously filed Exhibit 4 show that Hur's experiments were directed towards reduction to practice and continued through March 7, 2001. Thus, inventor activities in the U.S. establish diligence through March 7, 2001 by

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Furthermore, diligence activities attributable to the inventors continued after Mar. 7, 2001. Evidence for these activities includes par. 2 of Declaration II, which states:

- ✓ Dr. Cheong met with Attorney McCabe in Murray Hill, New Jersey, USA, on March 9, 2001 to help in preparation of a patent application for inventions related to MgB₂ layers and methods of making same.

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The evidence also includes pars. 1 – 2 of Declaration III where Attorney McCabe states “I … drafted provisional U.S. patent application no. 60/275,067…” and further states:

- On Friday, March 9, 2001, I met with Dr. Cheong in Murray Hill NJ, USA, to discuss the inventions that became the object of the '067 provisional patent application.

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The evidence also includes Exhibit A, which shows an entry on Dr. Cheong's calendar for Friday, March 9, 2001. The entry indicates a 2:00 PM meeting with “John – lawyer” [sic] thereby corroborating the above-described Mar. 9, 2001 meeting between Attorney John McCabe and Dr. Cheong.

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The above evidence shows that U.S. activities attributable to inventor diligence continued through Mar. 9, 2001. Since U.S. provisional patent application 60/275,067 was filed on Monday, Mar. 12, 2001, i.e., the workday following Mar. 9, 2001, there was no break in diligence activities up to filing. For that reason, the activities attributable to inventor diligence are sufficient to establish a date of invention for claim 8 that predates the March 8, 2001 publication of Brinkman.

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Due to the earlier date of invention, rejections of claim 8 based, in part, on Brinkman 8, should be withdrawn.

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For the above reasons, Applicants respectfully request allowance of independent claim 8 and of claims 9 – 18, which depend on claim 8.

No fee is believed due. In the event of any non-payment or improper payment of a required fee, the Commissioner is authorized to charge or to credit **Lucent Technologies Deposit Account No. 12-2325** to correct the error.

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Respectfully,



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10 Date: Feb, 23, 2004
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